



PRE-APPEAL BRIEF REQUEST FOR REVIEW	Docket Number (Optional) 060279.00067
I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)] on _____ Signature _____ Typed or printed Name _____	Application Number: 10/717,600
	Filed: November 21, 2003
	First Named Inventor: Kai MUSTONEN
	Art Unit: 2616 Examiner: C.B. PATEL

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a Notice of Appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

- ☐ Applicant/Inventor.
- ☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under
37 CFR 3.73(b) is enclosed

☒ Attorney or agent of record.
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☐ Attorney or agent acting under 37 CFR 1.34.
Reg. No. is acting under 37 CFR 1.34 _____

Signature

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Telephone number

January 23, 2008
Date

NOTE: Signatures of all of the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☐ *Total of _____ forms are submitted.



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: Kai MUSTONEN et al.

Serial No.: 10/717,600

Group Art Unit: 2616

Filed: November 21, 2003

Atty. Docket No.: 060279.00067

For: UTILIZATION OF GEOGRAPHIC LOCATION INFORMATION IN IP
ADDRESSING

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

January 23, 2008

Sir:

In accordance with the Pre-Appeal Brief Conference Pilot Program guidelines set forth in the July 12, 2005 Official Gazette Notice, Applicants hereby submit this Pre-Appeal Brief Request for Review of the final rejections of claims 22-46 in the above identified application. Claims 22-46 were finally rejected in the Office Action dated October 23, 2007. Applicants filed a Response to the Final Office Action on December 21, 2007, and the Office issued an Advisory Action dated January 14, 2008 maintaining the final rejections of claims 22-46. Applicants hereby appeal these rejections and submit this Pre-Appeal Brief Request for Review.

The Final Office Action rejected claims 22-25, 28-36, and 39-46 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,829,230 ("Tiuri"). Applicants submit that there is clear error with regard to the obviousness of at least one element of claim 22, 33, and 44-46, upon which claims 23-25, 28-32, 34-36, and 39-42 are dependent.

Applicants respectfully submit that the element, "wherein the geographical location information is coded in the suffix portion of the address," as recited in claim 22, and similarly recited in claims 33, and 43-46, would not have been obvious to one of ordinary skill in the art, that the Final Office Action has failed to establish a prima facie case of obviousness, and that, therefore, the final rejections are clearly improper and without basis.

The Final Office Action solely relies on the citation of *In re Japiske* to support its legal conclusion that “rearranging parts of an invention involves only routine skilled [sic] in the art,” and that the above limitation would have been obvious to one of ordinary skill in the art. (see Final Office Action at pages 3-7). Applicants respectfully submit that *In re Japiske* has limited relevance to the issue of obviousness as it relates to the claims of the present application, and is not sufficient to establish a prima facie case of obviousness.

The claim at issue in *In re Japiske* was directed to a hydraulic power press. The court held that the claim read on the prior art reference except as to the final limitation, “means disposed in alignment with said opening for contact by said depending means to start the pressing operation of said hydraulic press.” The court further held that the prior art reference, while not disclosing the final limitation, did disclose a starting switch in a different position, and that “there would be no invention in shifting the starting switch ... to a different position since the operation of the device would not thereby be modified.” (see *In re Japikse*, 86 USPQ 70, 73 (C.C.P.A. 1950)). Thus, the court’s holding was based on the reasoning that the rearrangement of parts would not modify the operation of the device because the placement of the starting switch did not modify how the hydraulic press operated. In contrast, coding the geographical location information in the suffix portion of the internet protocol address as opposed to the prefix portion, in the present invention, fundamentally modifies how embodiments of the present invention operate because it ensures that mobile devices will have unique MAC addresses, and thus, the mobile devices can be auto-configured. When the geographical location information is assigned to a prefix portion of the internet protocol address, auto-configuring of the address is not ensured because, in practice, several terminals can have the same address.

Furthermore, MPEP 2144.04 states that “the mere fact that a worker in the art could rearrange the parts of the reference device to meet the terms of the claims ... is not by itself sufficient to support a finding of obviousness. The prior art must provide a motivation or reason for the worker in the art, without the benefit of [the] specification, to make the necessary changes in the reference device.” (MPEP 2144.04; see also *Ex parte Chicago Rawhide Mfg. Co.*, 223 USPQ 353, 353 (Bd. Pat. App. & Inter. 1984)). The Final Office Action fails to provide a single motivation, that is disclosed or suggested by Tiuri, to code the geographical location information in the suffix portion of the internet protocol address as opposed to the prefix portion.

For these reasons, Applicants respectfully submit that the Final Office Action's reliance on *In re Japiske* is not sufficient to establish a prima facie case of obviousness.

In addition, Applicants submit that the Final Office Action fails to take into account that Tiuri teaches away from the present invention, specifically, coding geographical location information in the suffix portion of an internet protocol address, because Tiuri discloses coding geographical location information in the prefix portion of an internet protocol address.

Tiuri discloses that when a mobile terminal is registered with a cellular telecommunication network, the internet protocol address allocated to the terminal comprises a prefix corresponding to the location of the connection node and a suffix part corresponding to the terminal identity. (see Tiuri at col. 6, lines 9-15). As described above, when the geographical location information is assigned to a prefix portion of the internet protocol address, auto-configuring of the address is not ensured, because it is possible for several terminals can have the same address. Finally, if the prefix is generated from the geographical location information, the routing will change, and thus, the changes must be applied to all routers globally. (see Specification at col. 3, lines 17-29). Therefore, coding the geographical location in the suffix portion results in significant innovative advantages that are not disclosed, or suggested, in Tiuri.

In contrast, according to the embodiments of the present invention, by using the geographical location in the suffix portion, it can be ensured that mobile or stationary devices will have unique MAC addresses, and can be auto-configured. Furthermore, changes in the suffix portion do not require changes globally to the routing tables of routers. Tiuri fails to disclose or suggest any of these advantages, and thus, fails to disclose or suggest a motivation to modify the system of Tiuri to code the geographical location information in the suffix portion of the internet protocol address. Thus, Applicants respectfully submit that Tiuri teaches away from the present invention, specifically, coding geographical location information in the suffix portion of an internet protocol address.

Therefore, Applicants respectfully submit that the Final Office Action has failed to establish a prima facie case of obviousness, and that, therefore, the final rejections are clearly improper and without basis. As such, Applicants respectfully request that the rejection of claims 22, 33, and 43-46 be withdrawn.

Applicants submit that claims 23-25 and 28-32 are dependent upon claim 22, while claims 34-36 and 39-42 are dependent upon claim 33. Thus, claims 23-25, 28-32, 34-36, and 39-42 should be found allowable for at least their dependence upon claims 22 and 33, respectively, and for the specific limitations recited therein.

Claims 26 and 37 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Tiuri, in view of U.S. Patent No. 6,249,820 (“Dobbins”), and further in view of U.S. Patent No. 6,952,729 (“Bialk”). Claims 27 and 38 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Tiuri, in view of U.S. Patent No. 6,147,986 (“Orsic”). Applicants note that claims 26-27 and 37-38 are dependent upon claims 22 and 33, respectively. As stated above, Tiuri fails to disclose or suggest all of the elements of independent claims 22 and 33. Applicants submit that Dobbins, Bialk, and Orsic, like Tiuri, also fail to disclose or suggest “wherein the geographical location information is coded in the suffix portion of the address,” as recited in claim 22, and similarly recited in claim 33. As such, Dobbins, Bialk, and Orsic fail to cure the deficiencies in Tiuri discussed above. Consequently, the combination of Tiuri, Dobbins, and Bialk fails to disclose or suggest all the elements of claims 26, and the combination of Tiuri and Orsic fails to disclose all of the elements of claims 27 and 38. Furthermore, Applicants respectfully submit that claims 26-27 and 37-38 should be found allowable for at least their dependence on claims 22 and 33, respectively, and for the specific limitations recited therein.

The Final Office Action rejected claim 44 under 35 U.S.C. § 101 as being directed to non-statutory subject matter. Applicants submit that there is clear error with regards to the patentability of claim 44, and therefore, the final rejection is clearly improper and without basis.

The Advisory Action stated that “[a]mended claim 44 does not overcome [the] 35 U.S.C. 101 rejection since the claimed invention is claiming an IP address which is a data structure. Putting data structure on a computer-readable medium does not make it statutory since the IP address on a computer readable medium does not produce any useful result.” (see Advisory Action at page 2). Applicants respectfully submit that when functional descriptive material is recorded on some computer-readable medium, it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized. (see *In re Lowry*, 32 F.3d 1579, 1583-84, 32 USPQ2d 1031, 1035 (Fed. Cir. 1994)). In the context of descriptive material, data structures and

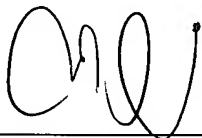
computer programs which impart functionality when employed as a computer component constitute functional descriptive material. (see MPEP 2106.01).

As described above, the coding of geographical information into the suffix portion of the internet protocol address, rather than the prefix portion, provides auto-configurable location-based addressing for mobile devices, which allows the device to change its internet protocol address when it changes its geographic location, without also requiring global changes to the routing tables of routers within the network. Thus, the data structure embodied on a computer-readable medium does provide a useful result, and thus, claim 44 is patentable subject matter under 35 U.S.C. § 101.

For at least the reasons discussed above, Applicants respectfully submit that the final rejections are clearly improper and without basis. It is therefore respectfully requested that all of claims 22-46 be allowed, and this application passed to issue.

Reconsideration and withdrawal of the rejections, in view of the clear errors in the Office Action, is respectfully requested. In the event this paper is not being timely filed, the applicants respectfully petition for an appropriate extension of time. Any fees for such an extension together with any additional fees may be charged to Counsel's Deposit Account 50-2222.

Respectfully submitted,



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Enclosures: PTO/SB/33 Form
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